



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/684,066	10/06/2000	Rama Ranganathan	UTSD:645US/MTG	2858

7590 11/15/2001

Mark T. Garrett  
FULBRIGHT & JAWORSKI L.L.P.  
SUITE 2400  
600 CONGRESS AVENUE  
AUSTIN, TX 78701

EXAMINER

CLOW, LORI A

ART UNIT	PAPER NUMBER
----------	--------------

1631

DATE MAILED: 11/15/2001

lf

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/684,066

Applicant(s)

RANGANATHAN ET AL.

Examiner

Lori A. Clow, Ph.D.

Art Unit

1631

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-34 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_ 6) ☐ Other: \_\_\_\_\_

Art Unit: 1631

Applicant is hereby notified that the required timing for the correction of drawings has changed. See the last 6 lines on the sheet which is attached entitled "Attachment for PTO-948 (Rev. 03/01 or earlier)". Due to the above notification Applicant is required to submit drawing corrections within the time period set for responding to this Office action. Failure to respond to this requirement may result in abandonment of the instant application or a notice of a failure to fully respond to this Office action.

***Restriction/Election***

Restriction to one of the following inventions is required under 35 U.S.C. § 121:

- I. Claims 1-18, drawn to methods of identifying positions in a polymer family, classified in class 702, subclasses 20, 22, and 27.
- II. Claims 19-29, drawn to identifying interacting monomers in a polymer family, classified in class 702, subclass 20.
- III. Claim30, drawn to identifying interacting amino acids in a protein family, classified in class 702, subclass 20.
- IV. Claim31, drawn to analyzing data of crystal structures, classified in class 702, subclass 27.
- V. Claims 32 and 33, drawn to analyzing effects of protein perturbation, classified in class 702, subclass 20.
- VI. Claim34, drawn to analyzing microarray data, classified in class 702, subclass 20.

The inventions are distinct, each from the other because of the following reasons:

Inventions of Group I and Group II are related in that they employ the use of the same method of identification. However, identification of positions in a polymer family verses identification of interacting monomers in a polymer family represent two unique analyses requiring not only identification of mere position in a sequence, but also comparing two or more sequences to identify potential interactions of monomers.

Inventions of Group I and III are related in that they also utilize the same method to identify positions in a polymer family as well as identifying interacting amino acids in a protein family. However, this represents two very different analyses, for the same reasons as stated above.

Inventions of Group I and IV are related in that they employ the same basic method of identifying position in a polymer family as is used to analyze data of a crystal structure. However, the inventions are distinct because methods of Group I and the methods of Group IV analyze physically and functionally distinct chemical entities, therefore causing undue search burden.

Inventions of Group I and Group V are related in that they employ the same method of identifying position and analyzing pertubation of proteins. However, the inventions are distinct because the methods of Group I and the methods of Group V analyze physically distinct properties, namely position and pertubation. Also, the invention of Group V introduces a new mathematical function for these analyses.

Inventions of Group I and Group VI are also related in that they employ the same method of identifying position and analyzing microarrays. However the inventions are distinct in that analysis of position in a polymer family and analysis of microarray data from various

Art Unit: 1631

sources, including DNA, represent analysis of physically and functionally distinct chemical entities. Furthermore, the invention of Group VI introduces another analytical formula.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

#### *Inquiries*

Papers related to this application may be submitted to Technical Center 1600 by facsimile transmission. Papers should be faxed to Technical Center 1600 via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform with the notices published in the Official Gazette, 1096 OG 30 (November 15, 1988), 1156 OG 61 (November 16, 1993), and 1157 OG 94 (December 28, 1993) (See 37 CFR § 1.6(d)). The CM1 Fax Center number is either (703) 308-4242, or (703) 308-4028.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lori A. Clow, Ph.D., whose telephone number is (703) 306-0511. The examiner can normally be reached on Monday-Friday from 9 A.M. to 5 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael P. Woodward, Ph.D., can be reached on (703) 308-4028.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to Patent Analyst, Pauline Farrier, whose telephone number is (703) 305-3550, or to the Technical Center receptionist whose telephone number is (703) 308-0196.

Application/Control Number: 09/684,066

Page 5

Art Unit: 1631

November 6, 2001

Lori A. Clow, Ph.D.

Art Unit 1631

LAC



MICHAEL P. WOODWARD  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1600